



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,045	04/24/2001	Joachim Endler	Q64014	3698

7590 09/11/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
----------	--------------

2645

8

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,045

Applicant(s)

ENDLER, JOACHIM

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-8 and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Kaplan (US 6,396,906).

Regarding **claim 1**, Kaplan discloses a telephone answering system that automatically calls back a caller (column 1, lines 6-10), (which reads on claimed “a telecommunication system”) comprising:

a first (108 on FIG. 1) and second terminal (column 3, line 21 “a message recipient”);

a switch (212 on FIG. 2) having a detector (208 on FIG. 2) and a processor (202 on FIG. 2);

a memory (104 on FIG. 1) for storing at least one message (column 3, line 23 “a message”) originating from the first terminal and destined for the second terminal, the at least one message being associated with a specific signal (column 3, line 25 “specify a number”) generated by the first terminal (column 3, lines 17-30) [The caller calls a message recipient and leaves message with a specify number at the telephone answering system];

the second terminal comprising:

a generator (column 4, line 3 “dialed”) for generating the specific signal to be sent to the switch, the specific signal indicating that a user of the second terminal (column 4, line 2 “the message recipient”) is interested in the at least one message associated with the specific signal, wherein in response to detecting the specific signal, the processor of the switch automatically orders the memory to generate and send the at least one message to the second terminal (column 4, lines 1-13) [The message recipient dialed the telephone answering system for the message left by the caller and for any particular message the instruction synthesizer informed the message recipient].

Regarding **claims 2 and 6**, Kaplan discloses wherein the specific signal comprises a destination signal defining a destination of the first terminal or comprises a predefined specific code (column 4, lines 1-13).

Regarding **claims 3 and 7**, Kaplan discloses wherein the first terminal comprises:

a further generator for generating an indication signal to be sent to the switch and identifying at least one message originating from a user of the first terminal being a specific message, the switch further comprising a detector for detecting the indication signal (column 3, lines 31-38).

Regarding **claims 4 and 8**, Kaplan discloses wherein the indication signal comprises at least a predefined indication code or a destination signal defining a destination of the second terminal (column 3, lines 39-60).

Regarding **claim 5**, Kaplan discloses a telephone answering system that automatically calls back a caller (column 1, lines 6-10), (which reads on claimed "a switch for use in a telecommunication") comprising:

a memory (206 on FIG. 2) for storing at least one message (column 3, line 23 "a message") originating from a first terminal (108 on FIG. 1) and destined for a second terminal (column 3, line 21 "a message recipient"), the at least one message being associated with a specific signal (column 3, line 25 "specify a number") generated by the first terminal (column 3, lines 17-30) [The caller calls a message recipient and leaves message with a specify number at the telephone answering system];

a detector (204 on FIG. 2) for detecting the specific signal originating from the second terminal, specific signal indicating that a user (column 4, line 2 "the message

recipient”) of the second terminal in interested in the at least one message associated with the specific signal, and wherein in response to detecting the specific signal, the processor of the switch automatically orders the memory to generate and send the at least one specific message to the second terminal (column 4, lines 1-13) [The message recipient dialed the telephone answering system for the message left by the caller and for any particular message the instruction synthesizer informed the message recipient. When the caller has left a phone number the message recipient is given the opportunity to call the caller].

Regarding **claim 10**, Kaplan discloses a telephone answering system that automatically calls back a caller (column 1, lines 6-10), (which reads on claimed “a method for use in a telecommunication system”) comprising:

storing at least one message (column 3, line 23 “a message”) originating from a first terminal (108 on FIG. 1) and destined for a second terminal (column 3, line 21 “a message recipient”) in a memory (column 3, lines 17-30) [The caller calls a message recipient and leaves message at the telephone answering system];

the at least one message being associated with a specific signal (column 3, line 25 “specify a number”) generated by the first terminal (column 3, lines 17-30) [The caller calls a message recipient and leaves message with a specify number at the telephone answering system];

generating the specific signal to be sent from the second terminal to a switch (212 on FIG. 2), wherein the specific signal indicates that a user (column 4, line 2 “the

Art Unit: 2645

message recipient") of the second terminal is interested in the at least one message associated with the specific signal (column 4, lines 1-13) [The message recipient dialed the telephone answering system for the message left by the caller and for any particular message the instruction synthesizer informed the message recipient];

detecting, by a switch (212 on FIG. 2), the specific signal and ordering, automatically in response to detecting the specific signal, the memory to generate the at least one specific message to be sent to the second terminal (column 4, lines 1-13) [The message recipient dialed the telephone answering system for the message left by the caller and for any particular message the instruction synthesizer informed the message recipient. When the caller has left a phone number the message recipient is given the opportunity to call the caller].

Response to Arguments

3. Applicant's arguments with respect to **claims 1-8 and 10** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.


g.g.
August 27, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

